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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/977,370	10/16/2001	Scott Carl Smith	A-7600	3961

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EXAMINER

ALLEN, ANDRE J

ART UNIT PAPER NUMBER

2855

DATE MAILED: 02/26/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/977,370

Applicant(s)

SMITH, SCOTT CARL

Examiner

Andre J. Allen

Art Unit

2855

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-15 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-15 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

**Priority under 35 U.S.C. §§ 119 and 120**

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

**Attachment(s)**

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 2.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other:

DETAILED ACTION

*Claim Rejections - 35 USC § 103*

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. Claims 1-15 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kim et al in view of Tsui et al. Kim et al teaches the basic features of the claimed invention for example:

In claims 1, and 10 securing a sample/measurement surface 7 to the top end of a column 9, 10 lowering a stylus/punch 21 to contact the sample and recording a vertical height (claim 1) of the stylus/punch; Moving the stylus/punch downward until the sample ruptures (claim 1), measuring the distance traveled by the stylus from the starting point and the rupture point (claim 1, 2), and measuring the force applied by the force applied by the stylus at rupture. (claim 1)

In claims 1 and 10 Kim et al does not explicitly teach contacting the sample until movement of the stylus is not possible without movement of the sample. However in figure 5 the punch 21 is clearly showing contacting the sample until movement of the stylus is not possible without movement of the

sample therefore, it would have been obvious to a person having ordinary skill in the art at the time the invention was made to use this function since Kim et al is clearly lowering a punch into a sample.

In claims 2 and 11 Kim et al does not disclose lowering the punch at a constant speed. However Kim et al teaches a material tester that includes moving a punch 21 to engage a test specimen 7 to apply a stretch force (claim 1) this teaching would clearly suggest a constant speed. Therefore, it would have been obvious to a person having ordinary skill in the art at the time the invention was made to modify a material testing apparatus to be lowered at a constant speed for the purpose of testing the strength of material.

In claims 6,15 Kim et al shows a sample 7 having a uniform thickness film {fig. 5}.

In claim 8 Kim et al does not teach forming an aperture in the bottom of said column for vacuum protecting however, Tsui teaches a material tester that lowers an indenter 4 and penetrates a sample 20 {col. 7 lines 20-25}and includes forming an aperture in the bottom of said column for vacuum protecting {col. 10 lines 1-5}. Therefore, it would have been obvious to a person having ordinary skill in the art at the time the invention was made to form a vacuum for the purpose seal an area through a passage as taught by Tsui et al.

In claims 3,9 and 12 with respect to a constant speed being 508.0 mm/min and the diameter of the stylus being 7mm and diameter of the column being 33mm. It would have been obvious to one having ordinary skill in the art at the time the invention was made to use this speed and dimensions since the cited prior art at least teaches a column and stylus, since it has been held that discovering an optimum value of a result effective variable involves only routine skill in the art. In re Bosch, 617 f.2d 272, 205 USPQ 215

In claims 4,5,13 and 14 the sample is a glove finger, palm or cuff, however it would have been obvious to a person having ordinary skill in the art at the time the invention was made to use a glove finger, thin film or metal, since it has been held to be within the general skill of a worker in the art to select a known material on the basis of its suitability for the intended use. In re Ileshin 125 USPQ 416

In claim 7 calculating the rupture strength of the sample by using the formula(05) Stylus Travel Distance Stylus Force/ Sample at Rupture at Rupture TI. However, since Kim et al in view of Tsui et al is teaching testing the strength of a material it would have been clearly obvious to a person having ordinary skill in the art at the time the invention was made to modify a test to include an equation for the purpose of calculating material strength.


*Conclusion*

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Andre J. Allen whose telephone number is 703-3081989. The examiner can normally be reached on mon-fri 8:00-4:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Hezron Williams can be reached on 703-305-4705. The fax phone numbers for the organization where this application or proceeding is assigned are 703-308-3432 for regular communications and 703-308-3432 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0956.

A.J.A  
February 14, 2003

  
HEZRON WILLIAMS  
SUPERVISORY PATENT EXAMINER  
TECHNOLOGY CENTER 2800